PATENT
Docket No. 42.P9786

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	)	
	)	
Steven DeNies et al.	)	Group Art Unit: 2644
	)	
Application No.: 09/593,532	)	Examiner: W. Briney III
	)	
Filed: June 14, 2000	)	
	)	
For: INTERFACE CLASS DISCOVERY METHOD AND DEVICE	)	
	)	

37 C.F.R. §§ 1.144 and 1.181 PETITION

Mail Stop **Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated September 15, 2005 (hereinafter "Office Action"), which made final most of the Restriction Requirement mailed February 18, 2005 (hereinafter "Restriction Requirement"), Applicants hereby petition the Director under 37 C.F.R. §§ 1.144 and 1.181.

In particular, Applicants respectfully invoke the supervisory authority of the Director to review the Restriction Requirement, for the reasons outlined below. Applicants previously requested reconsideration of the Restriction Requirement in the Response filed March 18, 2005.

CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below
By: Cathy Dikes (Cathy Dikes) Date: February 15, 2006

REMARKS

In the Restriction Requirement, the Examiner alleged that claims 1-6, 38, and 44 (Group I) and claims 7-36, 39, 40, and 45 (Group II) constitute "patentably distinct species;" and required election among these. In the event that Group II was elected, the Examiner required restriction among claims 8-22 (Subgroup A), claims 24 and 25 (Subgroup B), and claims 26-36 (Subgroup C). In the event that Subgroup A was elected, the Examiner required election among claims 8-13 (Sub-subgroup A) and claims 14-22 (Sub-subgroup B).

Although the Examiner withdrew the first election requirement between Groups I and II, he made final:

1) the restriction requirement among Subgroups A-C, and

2) the election requirement between Sub-subgroups A and B.

It is these two, final requirements that are the subject of this Petition.

M.P.E.P. § 803 states that for a restriction/election to be proper: "(A) The inventions must be independent . . . or distinct as claimed . . . ; and (B) There must be a serious burden on the examiner if restriction is required."

A. Subgroups not patentably distinct:

Applicants traverse the restriction requirement, because Subgroups A, B, and C are not patentably distinct. These Subgroups have neither achieved a separate status in the art, nor are separately usable. The particulars of this will be discussed with regard to claims 8 (Subgroup A), 24 (Subgroup B), and 26 (Subgroup C).

Regarding the alleged separate status in the art, Subgroups A, B, and C have been mischaracterized without regard to all of their limitations. Contrary to the somewhat spurious labels on pages 2 and 3 of the Restriction Requirement, each of claims 8, 24, and 26 is directed to a method of providing an indication signal. Each of claims 8, 24, and 26 includes multiple common limitations, such as analyzing to determine active conductors, grouping the active conductors, providing class information, determining a similarity to the class information, and providing an indication signal based on the similarity. The claims in Subgroups A, B, and C

plainly belong in the same class and subclass based on the large amount of common subject matter therein.

The Restriction Requirement on pages 2 and 3, by contrast, focuses *solely* (and improperly) on just the differences among Subgroups A, B, and C. The disparate classifications that the Examiner gives these three very similar groups of claims are:

1) 324/76.33 ("means to measure the similarity of two or more signals" -- indented under subclass 76.11 -- "MEASURING, TESTING, OR SENSING ELECTRICITY, PER SE").

2) 379/24 ("Subject matter including structure for providing a quantitative indication of an electrical characteristic of the line or trunk or the signal thereon.").

3) 379/1.04 ("rating the line quality for particular measurements (1) Note. For example, rating the line for baud rates 14.4 k or 28.8 k.").

Whatever the correct classification of claims 8 (Subgroup A), 24 (Subgroup B), and 26 (Subgroup C), it is likely that at least Subgroup C does not belong in rating line quality for measurements such as baud rates. Nor does Subgroup A appear to particularly belong under measuring and testing electricity "per se." Rather, the separate classifications have been alleged solely for the purposes of attempting to show different classification, and not because Subgroups A, B, and C actually fall into separate classifications. The restriction requirement among Subgroups A, B, and C is improper for at least these reasons.

Regarding the alleged separate utility on page 3 of the Restriction Requirement, this again ignores most of the recitations of claims 8 (Subgroup A), 24 (Subgroup B), and 26 (Subgroup C). While the narrow mis-characterization of "cross-correlation" for Subgroup A may indeed have other utility without the other claim limitations of claim 8, with these other limitations properly included the "method of providing an indication signal" plainly does not have utility in tone detection or echo cancellation as alleged on page 3 of the Restriction Requirement. Nor does claim 26 (Subgroup C), which also claims "a method of providing an indication signal" in similar detail as the other subgroups, reasonably have separate utility in "subscriber loop topology determination" as alleged. The restriction requirement among Subgroups A, B, and C is improper for at least the additional reason that the subgroups,

reasonably and completely interpreted, do not have separate utility. Applicants respectfully request that the claims of Subgroups A-C be examined together.

1. Examiner's response:

On page 2 of the Office Action dated September 15, 2005, the Examiner responds, "Clearly, these arguments are moot as they only identify differences between separate combinations (i.e. providing an indication signal and tone detection/echo cancellation) while ignoring that the subcombinations specifically recited are being subjected to a restriction requirement and not the linking claims" (emphasis in original).

2. Applicants' reply:

The Examiner again improperly focuses on differences among claims 8 (Subgroup A), 24 (Subgroup B), and 26 (Subgroup C). As noted in M.P.E.P. § 802.01, "Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect" (emphasis in original). Note that the M.P.E.P. does not refer to the differences among the claims or the "subcombinations specifically recited" (whatever that means). Subgroups A-C *as claimed* include too many common limitations to be properly classified differently or to be considered distinct. The Examiner's classification and treatment is thus arbitrary and incorrect.

For at least these reasons, the Restriction Requirement should be withdrawn, because Subgroups A, B, and C are not patentably distinct.

Because Subgroups A, B, and C have not acquired a separate status in the art, and because these groups are not distinct, all pending claims in Subgroups A, B, and C should be examined together.

B. No serious burden:

Regarding the election requirement, 37 C.F.R. § 1.141 and 1.146 contemplate examination of "a reasonable number of species." Applicants respectfully submit that "a reasonable number" of species, whatever such "reasonable number" is, must be greater than one, solitary species. Applicants respectfully request that Sub-subgroups A and B be examined together and this nested election requirement be withdrawn.

1. Examiner's response:

In the Office Action dated September 15, 2005, the Examiner alleges three combinations "each with two different species, creating a total of six different inventions to examine."

2. Applicants' reply:

Not so. Page 4 of the Restriction Requirement plainly indicates that this nested election requirement between two alleged species is solely related to Subgroup A, and not the other two Subgroups. In reality, rather than "six different inventions," the Examiner is quibbling over nine additional claims (i.e., claims 14-22).

At least independent claims 1, 7, 24, 26, 44, and 45 are similarly structured, and have similar subject matter therein. These independent claims are likely classified in a relatively small number of subclasses in the same class in the art. In summary, Applicants are claiming a single invention in multiple ways, and there is significant subject matter overlap between these ways. Applicants have paid the Office upon filing for all 45 of the pending claims, including extra fees for independent claims in excess of 3 and dependent claims in excess of 20. Given the single invention claimed herein and the strong similarity among claims, Applicants do not think it unreasonable to expect examination of all the claims for which the Office was paid.

For at least these reasons, the Restriction Requirement should be withdrawn, because there is no serious burden in examining all of Subgroups A-C and Sub-subgroups A and B.

Conclusion:

There is no "serious burden" to examine all pending claims, for which Applicants have paid. Nor are these claims patentably distinct. Accordingly, Applicants respectfully request under 37 C.F.R. §§ 1.144 and 1.181 that the Director instruct the Examiner to withdraw the Requirement for Restriction and to examine withdrawn claims 14-22 and 24-36.

Fees:

Because neither 37 C.F.R. § 1.144 nor 37 C.F.R. § 1.17 specifies a petition fee for petitions under 37 C.F.R. § 1.181, Applicant assumes that no fee is due for this petition. To the extent that a petition fee is in fact necessary, please charge any shortage in fees due in connection with the filing of this paper (e.g., such petition fee), including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess fees to such deposit account.

Respectfully submitted,

Dated: February 15, 2006

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